



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/752,805

01/07/2004

Nubar Ozbalik

EP-7621

5115

34769 7590 03/14/2007  
NEW MARKET SERVICES CORPORATION  
(FORMERLY ETHYL CORPORATION)  
330 SOUTH 4TH STREET  
RICHMOND, VA 23219

EXAMINER

LANG, AMY T

ART UNIT

PAPER NUMBER

3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

03/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/752,805

Applicant(s)

OZBALIK ET AL.

Examiner

Amy T. Lang

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☒ Claim(s) 1,21,51 and 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 12/08/2006. In particular, claims 1, 21, 38, 51, and 52. This combination of limitations was not present in the original claims. Thus, the following action is properly made final.

### ***Response to Arguments***

Applicant's arguments filed 12/08/2006 have been fully considered but they are not persuasive.

1. Specifically, applicant argues (A) that the rejection of claims 1-4, 8-10, 15-17, 21-24, 26, 28-30, and 35-37 in view of L'Heureux (US 6,300,290 B1) was conducted using hindsight reasoning.

With respect to argument (A), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, L'Heureux teaches every component disclosed in the claims since the instantly claimed "power transmission fluid" is an intended use claim and therefore given no

Art Unit: 3731

patentable weight. The examiner's position is supported by case law, which holds that "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) and MPEP 2111.02.

2. Specifically, applicant argues (B) that the rejection of claims 1-17 and 21-37 in view of Balasubramaniam (US 6,444,622 B1) teaches other examples than presently claimed.

With respect to argument (B), although Balasubramaniam discloses other additives and components in the composition than instantly claimed, every claim limitation is still met. Specifically, Balasubramaniam teaches a lubricating composition comprising natural or synthetic oils and a polyisobutylene viscosity index improver with a molecular weight from 800 to 5000 in claims 1, 4, and 22. Claim 18 discloses the lubricating composition as meeting the requirements for AGMA 9005-D94, which overlaps the instantly claimed kinematic and Brookfield velocities. Therefore, although Balasubramaniam teaches other components in the lubricating composition, Balasubramaniam specifically claims the instantly claimed components so that Balasubramaniam anticipates the present claims.

3. Specifically, applicant argues (C) that Rossi (US 6,468,948) does not teach that a fuel composition and a power transmission fluid can be substituted for each other.

With respect to argument (C), Rossi teaches additives known in the art are added to a fuel lubricating composition for improvement in various applications. These applications include use in power transmission fluids. Therefore, Rossi discloses that a fuel composition can be utilized as a power transmission fluid and include "additives to enhance performance" as a power transmission fluid (column 1, lines 31-33). Based upon these teachings by Rossi, it is the examiner's position that fuel composition can be substituted for use as a power transmission fluid.

4. Specifically, applicant argues (D) that L'Heureux (US 6,300,290 B1) discloses a two-cycle or engine oil and not a power transmission fluid.

With respect to argument (B), the instantly claimed "power transmission fluid composition" is an intended use phrase and therefore given no patentable weight. The examiner's position is supported by case law, which holds that "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) and MPEP 2111.02. With regard to claim 21, the phrase "a method of improving shear stability for a transmission fluid" would intrinsically be met by since L'Heureux discloses the same composition as is instantly claimed.

Art Unit: 3731

5. Specifically, applicant argues (E) that Sumiejski (US 6,103,673) does not teach that engine oil is interchangeable with a fluid for an entirely different part of a vehicle (ex. power transmission).

With respect to argument (E), Sumiejski discloses lubricating oil useful in transmissions (column 19, lines 56-58). Sumiejski then specifically discloses that these compositions are also "effective in a variety of applications" including two-cycle engines (column 19, lines 58-62). Therefore, Sumiejski does teach that a transmission lubricating oil can also be utilized as two-cycle engine oil.

### ***Claim Objections***

6. **Claims 1, 21, 51, and 52** are objected to because these claims all contain the word "friction" misspelled as "fiction."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 1, 21, 38, 51, and 52** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

Art Unit: 3731

application was filed, had possession of the claimed invention. Claims 1, 21, 38, 51, and 52 all recite "wherein the fluid has a friction drop at high speeds of less than 0.008." Although the table in the instant specification discloses lubricating compositions with max-min and max-300 values of 0.008 or less, the instant does not provide support that these values refer to the friction drop of the composition. Therefore, it is the examiner's position that the instant specification does not support these amended claims.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-4, 6, 8-10, 15-17, 21-24, 26, 28-30, 35-37, and 51** are rejected under 35 U.S.C. 102(b) as being anticipated by L'Heureux (US 6,300,290 B1).

L'Heureux discloses a lubricating oil composition comprised of base oil and a polyisobutylene viscosity index improver (column 1, lines 28-46). The base oil is further disclosed as natural or synthetic oils, or mixtures, such as mineral oils or an ester (column 3, lines 1-9, 54-57). The base oil is present in the composition from 20 to 70 wt%, which clearly overlaps the instantly claimed range of 5 to 20 wt% (column 1, lines 45-46).

The polyisobutylene viscosity index improver is disclosed with an average molecular weight from 300 to 1500, with 950 being the preferred amount, measured by

Art Unit: 3731

gel permeation chromatography (column 1, lines 54-67). These viscosity index improvers are present in the lubricating composition from 3 to 50 wt% (column 1, lines 37-40).

L'Heureux discloses the lubricating composition with a kinematic viscosity of 6.5 to 14 cSt at 100 degrees Celsius and a Brookfield viscosity of less than 17,000 cP at -40 degrees Celsius (column 1, lines 32-36; column 2, lines 63-67).

Other additives are included in the lubricating composition including corrosion inhibitors, friction modifiers, antifoaming agents, dispersants, and antiwear agents (column 4, lines 17-22). These additives are present in the lubricating composition from 1 to 25 wt% (column 4, lines 12-16). The antifoam additive is further disclosed as a silicone based component (column 4, lines 62-63). L'Heureux also discloses a second viscosity index improver, which inherently functions as a thickening agent, as polymethacrytes. These additives are present in the composition from 0.02 to 0.5wt% (column 2, lines 29-40).

However, L'Heureux does not specifically disclose (i) the friction versus velocity curve or the friction drop for the disclosed lubricating oil and (ii) that the lubricating oil is suitable for use in a continuously variable transmission or transmission employing the instantly claimed torque converters.

With respect to (i), since L'Heureux discloses the same composition as is instantly claimed and the addition of a polyisobutylene viscosity index improver, the lubricating composition would also inherently display a more positive slope on a friction vs. velocity plot with the polyisobutylene. Additionally, the composition of L'Heureux



would therefore also display the same friction drop as is instantly claimed, absent evidence to the contrary.

With respect to (ii), since the lubricating composition disclosed by L'Heureux clearly overlaps the instantly claimed composition, it would also inherently be suitable for use in a continuously variable transmission or transmission employing the instantly claimed torque converters.

Therefore, L'Heureux '290 anticipates the cited present claims.

11. **Claims 1-17, 21-37, and 51** are rejected under 35 U.S.C. 102(b) as being anticipated by Balasubramaniam (US 6,444,622 B1) in view of the evidence given by Performance Filtration Inc, Mark Barnes, and Science and Engineering Encyclopedia.

Balasubramaniam discloses a lubricating composition comprised of base oil and a polyisobutylene viscosity index improver (column 2, lines 50-53; column 11, lines 20-25). The base oil is further disclosed as natural lubricating oils, synthetic lubricating oils, and mixtures, including mineral oils, vegetable oils, and ester (column 2, line 65 through column 3, line 1; column 3, lines 10-13, column 4, lines 54-55).

Balasubramaniam discloses the base oil with a kinematic viscosity from 2 to 8 cSt at 100 degrees Celsius (column 3, lines 4-9).

The polyisobutylene viscosity index improver is disclosed with an average molecular weight from 800 to 5000 as measured by gel permeation chromatography (column 11, lines 8-38). One example specifically discloses the use of the viscosity index improver as 20 wt%, which clearly overlaps the instantly claimed range (column

Art Unit: 3731

16, lines 6-7). Additionally Balasubramaniam teaches the polyisobutylenes as hydrogenated to increase their stability (column 11, lines 54-57).

Other additives are included in the lubricating composition including ashless dispersants, friction modifiers, antioxidants, antiwear agents, defoamers, and corrosion inhibitors (column 7, lines 10-16). The dispersant is further disclosed as alkenyl succinimides, Mannich bases, and alkenyl succinic acid esters (column 6, lines 19-25). The friction modifier is further disclosed as an alkoxyated fatty amine or ether amine (column 14, lines 8-27). The disclosed antioxidant comprises sterically hindered phenols (column 9, lines 18-33). The antiwear agent is disclosed as a salt of a phosphate ester (column 10, lines 32-38). The defoamers comprise silicones and polyacrylates (column 8, lines 30-33). These additives are present from 2 to 25 wt% of the lubricating composition (column 7, lines 23-25). Additionally, Balasubramaniam discloses another viscosity index improver, which inherently functions as a thickening agent, as an olefin copolymer or a polymethacrylate (column 11, lines 8-11).

However, Balasubramaniam does not specifically disclose (i) the friction versus velocity curve or the friction drop for the disclosed lubricating oil, (ii) that the lubricating oil is suitable for use in a continuously variable transmission or transmission employing the instantly claimed torque converters, and (iii) the kinematic and Brookfield viscosity of the lubricating composition.

With respect to (i), since Balasubramaniam discloses the same composition as is instantly claimed and the addition of a polyisobutylene viscosity index improver, the lubricating composition would also inherently display a more positive slope on a friction

Art Unit: 3731

vs. velocity plot with the polyisobutylene. Additionally, the composition of Balasubramaniam would therefore also display the same friction drop as is instantly claimed, absent evidence to the contrary.

With respect to (ii), since the lubricating composition disclosed by Balasubramaniam clearly overlaps the instantly claimed composition, it would also inherently be suitable for use in a continuously variable transmission or transmission employing the instantly claimed torque converters.

With respect to (iii), Balasubramaniam discloses the lubricating oil composition with a velocity classification of ISO 32 according to AGMA 9005-D94 (column 15, lines 11-14). This velocity classification determines the velocity range for a lubricant and the MSDS Data Sheet for an ISO 32 grade lubricant is disclosed with a viscosity of 5.8 cSt at 100 degrees Celsius (Performance Filtration Inc). Therefore, in view of the evidence given by the MSDS Data Sheet, the lubricant disclosed by Balasubramaniam would also be within the range of 5.8 cSt. Furthermore, the website Practicing Oil Analysis by Mark Barnes provides evidence that Brookfield velocity is the same as dynamic velocity (page 1, line 7; page 3, lines 9-13). Dynamic velocity and kinematic velocity are related by density, as given by the evidence of Science and Engineering Encyclopedia (page 1). Therefore, since the lubricant disclosed by Balasubramaniam overlaps the instantly claimed kinematic velocity, it would also overlap the instant Brookfield velocity, since they are related by density.

Therefore, Balasubramaniam '622 anticipates the cited present claims.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. **Claims 38, 39, 41, 42, 47, and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Heureux (US 6,300,290 B1) in view of Rossi (US 6,468,948).

L'Heureux, as discussed in paragraph 10 is incorporated here by reference, discloses a lubricating oil composition comprised of base oil and a polyisobutylene viscosity index improver. The lubricating oil is added to a fuel in an amount of 5 wt% (20 parts by weight of fuel to 1 part by weight of lubricating oil) (column 6, lines 56-60).

L'Heureux does not specifically disclose the lubricating oil for use as a power transmission fluid.

Rossi discloses that fuel compositions can be utilized as power transmission fluids (column 1, lines 30-43). Therefore, it would have been obvious to also utilize the fuel composition disclosed by L'Heureux as a power transmission fluid.

Art Unit: 3731

15. **Claims 7 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Heureux (US 6,300,290 B1) in view of Wu (US 4,912,272).

L'Heureux, as discussed in paragraph 10 is incorporated here by reference, discloses a lubricating oil composition comprised of base oil and a polyisobutylene viscosity index improver.

L'Heureux does not disclose the polyisobutylenes as hydrogenated.

Wu discloses a lubricating composition exhibiting superior lubricant properties including a high viscosity index (column 1, lines 5-7). This property is due to the addition of hydrogenated polyisobutylene viscosity index improvers in the lubricating composition (claim 1, column 11). Since L'Heureux also discloses polyisobutylene viscosity index improvers in a lubricating composition, it would have been obvious to also hydrogenate the polyisobutylene and therefore improve the lubricating properties of the composition.

16. **Claim 40** is rejected under 35 U.S.C. 103(a) as being unpatentable over L'Heureux (US 6,300,290 B1) in view of Rossi (US 6,468,948) and Wu (US 4,912,272).

L'Heureux and Rossi, as discussed in paragraph 14 are incorporated here by reference, disclose a lubricating oil composition comprised of base oil and a polyisobutylene viscosity index improver.

L'Heureux does not disclose the polyisobutylenes as hydrogenated.

Wu discloses a lubricating composition exhibiting superior lubricant properties including a high viscosity index (column 1, lines 5-7). This property is due to the

Art Unit: 3731

addition of hydrogenated polyisobutylene viscosity index improvers in the lubricating composition (claim 1, column 11). Since L'Heureux also discloses polyisobutylene viscosity index improvers in a lubricating composition, it would have been obvious to also hydrogenate the polyisobutylene and therefore improve the lubricating properties of the composition.

17. **Claims 43-47** are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Heureux (US 6,300,290 B1) in view of Rossi (US 6,468,948) and Balasubramaniam (US 6,444,622 B1).

L'Heureux and Rossi, as discussed in paragraph 14 are incorporated here by reference, discloses a lubricating oil composition comprised of base oil, a polyisobutylene viscosity index improver, and additives. This lubricant is utilized in engines when mixed with fuels (column 6, lines 35-37). The additives disclosed by L'Heureux include corrosion inhibitors, friction modifiers, antifoaming agents, dispersants, and antiwear agents.

L'Heureux does not specifically disclose the additives that are instantly claimed.

Balasubramaniam, as discussed in paragraph 6 is incorporated here by reference, also discloses a lubricating oil composition comprised of base oil, a polyisobutylene viscosity index improver, and additives. This lubricant is also utilized in the automotive industry (column 1, lines 13-15). Balasubramaniam discloses specific additives including alkenyl succinimides, Mannich bases, and alkenyl succinic acid ester dispersants, alkoxylated fatty amine or ether amine friction modifiers, sterically hindered

Art Unit: 3731

phenol antioxidants, a salt of a phosphate ester antiwear agent, and silicone and polyacrylate defoamers. Given that this lubricant, with the disclosed additives, exhibits improved performance properties, it would have been obvious for L'Heureux to also include these specific additives in the lubricating composition since both inventions pertain to the automotive industry.

18. **Claims 18, 19, and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Heureux (US 6,300,290 B1) in view of Sumiejski (US 6,103,673).

L'Heureux, as discussed in paragraph 10 is incorporated here by reference, discloses a lubricating oil composition comprised of base oil, and a polyisobutylene viscosity index improver

L'Heureux does not specifically disclose the use of the lubricant composition in an automatic transmission or constantly variable transmission.

Sumiejski discloses that it is known in the art for two-cycle lubricants to also be utilized in automatic and constantly variable transmissions (column 19, line 56 through column 20, line 5). It therefore would have been obvious to utilize the lubricant disclosed by L'Heureux in an automatic transmission or an automatic transmission comprising a constantly variable transmission.

19. **Claims 48, 49, and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Heureux (US 6,300,290 B1) in view of Rossi (US 6,468,948) and Sumiejski (US 6,103,673).

L'Heureux and Rossi, as discussed in paragraph 14 are incorporated here by reference, disclose a lubricating oil composition comprised of base oil, and a polyisobutylene viscosity index improver. This lubricant is utilized in two-cycle engines in an amount of 5 wt% (20 parts by weight of fuel to 1 part by weight of lubricating oil) (column 1, lines 1-14; column 6, lines 56-60).

The combination of L'Heureux and Rossi does not specifically disclose the use of the lubricant composition in an automatic transmission or constantly variable transmission.

Sumiejski discloses that it is known in the art for two-cycle lubricants to also be utilized in automatic and constantly variable transmissions (column 19, line 56 through column 20, line 5). It therefore would have been obvious to utilize the lubricant disclosed by L'Heureux in an automatic transmission or an automatic transmission comprising a constantly variable transmission in an amount of 5 wt%.

20. **Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over L'Heureux (US 6,300,290 B1) in view of Sumiejski (US 6,103,673) and Landa (US 2002/0130010 A1).

L'Heureux and Sumiejski, as discussed in paragraph 18 are incorporated here by reference, disclose a lubricating oil composition comprised of base oil, and a polyisobutylene viscosity index improver utilized in automatic transmissions.

The combination of L'Heureux and Sumiejski do not disclose the automatic transmission with a carbon fiber friction plate.



Art Unit: 3731

Landa discloses that it is known in the art for automatic transmissions to contain friction plates of carbon fiber ([0001], [0017]). Therefore, it would have been obvious for the lubricating composition disclosed by L'Heureux to be utilized in automatic transmissions with a carbon fiber friction plate.

21. **Claim 50** is rejected under 35 U.S.C. 103(a) as being unpatentable over L'Heureux (US 6,300,290 B1) in view of Rossi (US 6,468,948), Sumiejski (US 6,103,673), and Landa (US 2002/0130010 A1).

L'Heureux, Rossi, and Sumiejski, as discussed in paragraph 16 are incorporated here by reference, disclose a lubricating oil composition comprised of base oil, and a polyisobutylene viscosity index improver utilized in automatic transmissions.

The combination of L'Heureux, Rossi, and Sumiejski do not disclose the automatic transmission with a carbon fiber friction plate.

Landa discloses that it is known in the art for automatic transmissions to contain friction plates of carbon fiber ([0001], [0017]). Therefore, it would have been obvious for the lubricating composition disclosed by L'Heureux to be utilized in automatic transmissions with a carbon fiber friction plate.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §

Art Unit: 3731

706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Lang whose telephone number is (571) 272-9057. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3731

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

02/16/2007  
Amy T. Lang

ATL

  
ANH TUAN T. NGUYEN  
SUPERVISORY PATENT EXAMINER

2/19/07